

### **REMARKS**

In the outstanding non-final Office Action<sup>1</sup> ("Office Action"), the Examiner objected to a perceived informality in the Specification, and rejected claims 1, 3-18, 31, and 33-35 under 35 U.S.C. § 112, second paragraph, as being "indefinite for failing to particularly point out and distinctly claim the subject matter applicant regards as the invention." Office Action at page 2. Below, Applicant respectfully traverses the above identified objection and rejection.

**1. The Examiner's objection to the disclosure should be withdrawn in light of the following clarification**

In the Office Action, the Examiner objected to the Applicant's use of the word "hush" in the specification and drawings, and requested clarification regarding whether the Applicant intended instead to use the word "hash." The Applicant does intend to use the word "hash," and appropriate amendments to the Specification and Figures have been made. See Amendments to the Specification on pages 2-3 of this paper and the attached Replacement Drawing sheets.

**2. The rejection of claims 1, 3-18, 31, and 33-35 under 35 U.S.C. § 112, second paragraph, should be withdrawn**

The Office Action rejected claims 1, 3-18, 31, and 33-35 under 35 U.S.C. § 112, second paragraph, as being "indefinite for failing to particularly point out and distinctly

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

claim the subject matter which applicant regards as the invention.” Office Action at page 2.

The Office Action alleges that the following recitations within claims 1 and 31 respectively invoke 35 U.S.C. § 112, sixth paragraph because “the recitation ‘examiner’ is equivalent to a recitation of ‘means.’” *Id.* at page 3.

Claim 1:

“an examiner for examining usage space information of the content data, the first medium, the reproducing apparatus, the second medium, and the recording apparatus”

Claim 31:

“an examiner for examining usage space information of the content data, the recording medium, and the reproducing apparatus”

The Applicant respectfully disagrees with the Office Action’s contention that claims 1 and 31 invoke 35 U.S.C. § 112, sixth paragraph. As these claims do not recite the word “means,” Applicant is entitled to the presumption that 35 U.S.C. § 112, sixth paragraph does not apply to these claims. And the Office Action has failed to successfully rebut this presumption.

The Office Action contends that this presumption is rebutted because the above-cited claim elements recite functions “without reciting sufficient structure for performing” those functions. Office Action at page 4. Particularly, the Office Action asserts that each of the above-recited claim elements includes the function “examining usage space information” and “one of ordinary skill in the art at the time of the invention would not understand ‘examiner’ to denote sufficient structure for performing that function.” *Id.* at pages 4-5. To support its above assertion, the Examiner first states that technical dictionaries such as the IEEE Standard Computer Dictionary do not contain a definition of “examiner.” Further, the Examiner states that despite “consult[ing] the instant

specification,” he/she is “unable to locate any usage of ‘examiner’ consistent with this element denoting structure.” *Id.* at page 5.

Although, “an examiner for examining usage space information ...” arguably recites a function, the Office Action’s further contention that one of ordinary skill in the art would not understand “examiner “ to denote sufficient structure for performing that function, is seriously flawed.

First, it is not necessary that a claim term be described in a technical dictionary, for that claim term to have meaning to a person of ordinary skill in the art. The claim term “examiner” viewed not in isolation, but in the context of the specification, indeed provides the person of ordinary skill with the information necessary to understand the structures involved in “examining usage space information of the content data, the first medium, the reproducing apparatus, the second medium, and the recording apparatus,” as recited in claim 1, and “examining usage space information of the content data, the recording medium, and the reproducing apparatus,” as recited in claim 31.

Second, contrary to the Office Action’s contention, Applicant’s specification does contain embodiments of the claim term “examiner” that would indicate to the person of ordinary skill the related structures involved . Moreover, there is no requirement that a claim term be repeated verbatim in the specification. Rather, claim limitations may be supported in the specification “through express, implicit, or inherent disclosure”. See MPEP 2161(I)(B) citing *In re Oda*, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971).

In this case, Applicant’s specification discloses several embodiments of the claim element ‘examiner’ that denote structure for performing various functions, including “examining usage space information.” In many of these embodiments, the ‘examiner’

comprises one or more SAM (secure application module) chips (Figures 29-34 and 36-37), or one or more SAM chips used in combination with one or more CPU apparatuses (Figure 35). The Specification also describes a SAM chip as “performing processing such as clearing of rights and decryption of content data,” as well as “copy control.” Specification at pages 27, lines 6-7; 23, lines 6-9. Some embodiments of ‘examiner’ involve the cooperation of several components in performing ‘usage space examination’:

[W]hen copying as shown in for example, FIG. 14, a usage space examination is performed by the following procedure. First, the reproduction side examines the usage space between the medium and the hardware. For this purpose, first, the media SAM of the recording medium on the reproduction side sends its own information to the reproduction apparatus ... Next ... it authenticates between the medium and the hardware and transfers all of the secure data for which the session keys are held at the two sides and described in the media SAM to the SAM of the hardware. Due to this, the usage space examination of the reproduction side ends. Next, the recording side as well similarly examines the usage space between the recording apparatus and the recording medium.

Specification at page 39, line 16 - page 40, line 15 (Emphasis added). According to other embodiments of the ‘examiner,’ usage space examination is “carried out by the apparatuses of both sides,” and involve both the host CPU on the reproduction and the recording sides. Specification at page 54, lines 3-12. Moreover, according to other embodiments of the ‘examiner,’ the “usage space examination is carried out between the reproduction apparatus and medium.” Specification at page 54, lines 15-16.

As shown above, the Specification and Figures contain, contrary to the Office Action’s contention, several embodiments of Applicant’s ‘examiner’ as claimed denoting structures involved in “examining usage space information of the content data, the first medium, the reproducing apparatus, the second medium, and the recording apparatus,”

as recited in claim 1, and "examining usage space information of the content data, the recording medium, and the reproducing apparatus," as recited in claim 31. A person of ordinary skill viewing Applicant's 'examiner' within the context of the Specification and Figures, would indeed understand the term to denote sufficient structure for performing "usage space examination" as recited in the above-recited elements of claims 1 and 31. Therefore, the Office Action has failed to successfully rebut the presumption that 35 U.S.C. § 112, sixth paragraph does not apply to claims 1 and 31.

As the foregoing remarks establish that claims 1, 3-18, 31, and 33-35 comply with the requirements of 35 U.S.C. § 112, second paragraph, Applicant respectfully requests the withdrawal of the associated claim rejections.

### **Conclusion**

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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